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Filed

OCT 15 2013

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CLERK, U.S. DISTRICT COURT
NORTHERN DISTRICT OF CALIFORNIA
SAN JOSE

11 UNITED STATES DISTRICT COURT
12 NORTHERN DISTRICT OF CALIFORNIA
13 SAN JOSE DIVISION

14 *In re Ex Parte Application of Nokia Corporation,*

15 Applicant,

16 For an Order Pursuant to 28 U.S.C. § 1782 Granting
17 Leave to Obtain Discovery From Google Inc. for
18 use in Foreign Proceeding.

CV 13 80217 MISC.

Case No.:
**EX PARTE APPLICATION FOR AN
ORDER PURSUANT TO 28 U.S.C. § 1782
GRANTING LEAVE TO OBTAIN
DISCOVERY FOR USE IN FOREIGN
PROCEEDING AND SUPPORTING
MEMORANDUM**

19 [Declaration of Casondra K. Ruga; and
20 (Proposed) Order filed concurrently herewith]

1 Nokia Corporation (“Nokia”), applies to the Court *ex parte* for an order pursuant to 28 U.S.C.
 2 § 1782 granting leave to obtain targeted discovery from Google Inc. (“Google”) for use in foreign
 3 litigation between Nokia and HTC Corporation and its subsidiaries (“HTC”).¹ This application is
 4 supported by the memorandum of points and authorities below and the Declaration of Casondra K.
 5 Ruga (“Ruga Decl.”) filed concurrently herewith. Though not required for this *ex parte* application,
 6 Nokia has provided courtesy notice of its intent to file this application to Google and HTC
 7 Corporation. (Ruga Decl., ¶ 22.) Section IV provides additional information on the appropriateness
 8 of pursuing and granting this application *ex parte*. The proposed subpoena is attached to this
 9 application as Exhibit A.

10 **I. INTRODUCTION**

11 Nokia is pursuing multiple patent infringement actions against HTC in England and Germany.
 12 In support of that litigation, Nokia has previously sought from this Court narrowly tailored discovery
 13 from Google regarding Google-supplied features in the HTC products and features at issue in several
 14 pending foreign cases. *See In re Ex Parte Application of Nokia Corporation*, Case No. 5:13-mc-
 15 80167-EJD (HRL). Since filing its previous application, Nokia filed a new patent infringement action
 16 against HTC in the Düsseldorf Regional Court of Germany. This new German action relates to
 17 navigation technology not at issue in Nokia’s prior subpoena application, including the use of Google
 18 Maps and Google Navigation in HTC devices sold in Germany. Nokia therefore submits this new
 19 application seeking narrowly tailored discovery from Google relating to these features that Google
 20 supplies for HTC products.

21 Nokia brings this application for leave to obtain requested discovery under 28 U.S.C. § 1782,
 22 which permits interested parties, such as Nokia, to obtain discovery from companies located within
 23 the United States for use in foreign litigation. Section 1782 has three statutory requirements, all of
 24 which are satisfied in Nokia’s application. First, the application is filed in “the district in which [the]
 25 person resides” because Google is headquartered in Mountain View, California. 28 U.S.C.
 26 §1782(a). Second, Nokia seeks the discovery “for use in a proceeding in a foreign . . . tribunal,”
 27

28 ¹ HTC Corp., HTC Europe Co. Ltd., and HTC Germany GmbH are all named defendants.

1 specifically in the Düsseldorf Regional Court in Germany. *Id.* Third, Nokia is a party to the foreign
 2 proceeding and therefore an “interested person[.]” *Id.*; *Intel Corp. v. Advanced Micro Devices, Inc.*,
 3 542 U.S. 241, 256 (2004) (litigants are common example of “interested persons”).

4 Moreover, all factors identified by the Supreme Court to guide a court’s discretion in
 5 analyzing Section 1782 applications favor granting Nokia’s request. Specifically, Google is not a
 6 party to the German proceeding, and Section 1782 provides an effective mechanism for obtaining
 7 this targeted discovery.² In addition: (i) the foreign jurisdiction at issue is receptive to the type of
 8 discovery sought by Nokia; (ii) the discovery provides key information for the foreign proceeding;
 9 (iii) the request is not made to circumvent any limitation on discovery imposed by the foreign court;
 10 and (iv) the proposed discovery requests are narrowly tailored and are not unduly intrusive or
 11 burdensome.

12 To the extent the documents requested contain confidential business information, Nokia will
 13 agree to reasonable measures to protect the information from disclosure, as may be appropriate.
 14 Accordingly, Nokia respectfully requests that the Court enter an order permitting Nokia to serve the
 15 subpoena, attached as Exhibit A to this application.

16 **II. JURISDICTION (CIVIL L.R. 3-5(a) STATEMENT)**

17 The Court has jurisdiction to hear this request pursuant to 28 U.S.C. § 1782, which provides
 18 that “[t]he district court of the district in which a person resides or is found may order him to give his
 19 testimony or statement or to produce a document or other thing for use in a proceeding in a foreign
 20 or international tribunal” Google is headquartered in Mountain View, California, and therefore
 21 resides in, and is found in, the Northern District of California.

22 **III. INTRADISTRICT ASSIGNMENT (CIVIL L.R. 3-5(b) STATEMENT)**

23 This action should be assigned to the San Jose Division. This application seeks leave to take
 24 discovery from Google, which is headquartered in Mountain View. Mountain View is in Santa
 25 Clara County and therefore within the San Jose Division. Civil L.R. 3-2(e). The documents
 26

27 ² Furthermore, even if Google were to intervene in the German proceeding, as it has done in some
 28 prior litigation involving Nokia and HTC, no comparable mechanism for obtaining this targeted
 discovery exists in that proceeding

1 implicated by Nokia's discovery requests are therefore likely to be located within the San Jose
 2 Division. *See Civil L.R. 3-2(c).* Applicant Nokia Corp.'s subsidiary Nokia Inc. also maintains an
 3 office in the Court's San Jose Division at 200 South Mathilda Ave, Sunnyvale, California.

4 **IV. APPROPRIATENESS OF *EX PARTE* RELIEF (CIVIL L.R. 7-10)**

5 Nokia's *ex parte* application is the appropriate vehicle for seeking the proposed discovery
 6 from Google pursuant to Section 1782. As this Court has explained:

7 [I]t is common for the process of presenting the request to a court and to obtain the
 8 order authorizing discovery [under 28 U.S.C. § 1782] to be conducted *ex parte*. Such
 9 *ex parte* applications are typically justified by the fact that the parties will be given
 adequate notice of any discovery taken pursuant to the request and will then have the
 opportunity to move to quash the discovery or to participate in it.

10 *In re Republic of Ecuador*, 2010 WL 3702427 at *3 (N.D. Cal. Sept. 15, 2010) (internal quotations
 11 and citations omitted); *see also In re Roebers*, 2012 WL 2862122 at *2 (N.D. Cal. July 11, 2012)
 12 ("An *ex parte* application is an acceptable method for seeking discovery pursuant to §1782."); *In re*
 13 *Republic of Ecuador*, 2010 WL 4027740 at *2 (E.D. Cal. Oct. 14, 2010) (similar). Indeed, other
 14 California District Courts have recently granted multiple *ex parte* Section 1782 applications filed by
 15 Nokia in support of to foreign proceedings between Nokia and HTC. *See In re Ex Parte Application*
 16 *of Nokia Corp. and Nokia GmbH.*, 12-cv-2653-BEN (WMC), slip op. (S.D. Cal. Nov. 19, 2012)
 17 (Ruga Decl., ¶ 9, Exh. 2); *In re Ex Parte Application of Nokia Corp.*, 13-CV-1152-WQH (BLM),
 18 slip op. (S.D. Cal. June 24, 2013) (Ruga Decl., ¶ 13, Exh. 6); *In re Ex Parte Application of Nokia*
 19 *Corp.*, 8:13-mc-00011-UA (AN), slip op. (C.D. Cal. May 21, 2013) (Ruga Decl., ¶ 14, Exh. 7).

20 Nokia's application is ripe for immediate decision, and the Court need not await action from
 21 other parties before ruling on Nokia's application. *See In re Republic of Ecuador*, 2010 WL
 22 3702427 at *3.

23 **V. BACKGROUND**

24 By this application, Nokia seeks a limited scope of technical documents from Google
 25 relevant to one Nokia patent asserted against HTC in Germany: EP 0 766 811 B1 ("EP 811
 26 patent").³ (Ruga Decl., ¶ 2). Nokia's infringement allegations for this patent target HTC products

27
 28 ³ The EP 811 patent is owned by Nokia's subsidiary HERE.

1 equipped with Google's Android operating system software, in connection with Google servers, to
 2 provide features of the Google Maps and Google Navigation applications. (*Id.*, ¶ 3). These accused
 3 features are provided by Google-supplied, preinstalled software in the accused HTC devices operating
 4 in connection with Google servers. (*Id.*). This patent is currently in active litigation against HTC in
 5 the German Regional Court of Düsseldorf. (*Id.*, ¶ 5). Google's technical documents relating to these
 6 services are therefore important to Nokia's infringement actions against HTC.

7 Google is not a party to the action for which Nokia seeks discovery (*Id.*, ¶ 6). Even if Google
 8 intervenes in the action, discovery comparable to that sought in this application is not available from
 9 Google in the German proceeding (*Id.*, ¶ 8). Google's principal place of business is located at 1600
 10 Amphitheatre Parkway in Mountain View, California, 94043, within in the San Jose Division of the
 11 Northern District of California. (*Id.*, ¶ 4).

12 **VI. ARGUMENT**

13 **A. Legal Standard**

14 Under 28 U.S.C. § 1782, a district court may order a person residing or found within its
 15 district to produce documents or testimony for use in a foreign legal proceeding, unless the
 16 disclosure would violate a legal privilege. 28 U.S.C. § 1782(a); *Intel Corp. v. Advanced Micro*
 17 *Devices, Inc.*, 542 U.S. 241, 246-47 (2004). Section 1782 provides in part:

18 The district court of the district in which a person resides or is found may order him
 19 to give his testimony or statement or to produce a document or other thing for use in a
 20 proceeding in a foreign or international tribunal The order may be made
 21 . . . upon the application of any interested person and may direct that the testimony or
 22 statement may be given, or the document or other thing be produced, before a person
 23 appointed by the court.

24 28 U.S.C. § 1782(a).

25 The statute may be invoked where: ““(1) the person from whom discovery is sought resides
 26 or is found in the district of the district court to which the application is made, (2) the discovery is
 27 for use in a proceeding before a foreign tribunal, and (3) the application is made by a foreign or
 28 international tribunal or ‘any interested person.’” *In re Republic of Ecuador*, 2010 WL 3702427,
 2012 WL 2862122.

1 In *Intel*, the Supreme Court set forth several non-exclusive factors to aid district courts in
 2 determining how to exercise their discretion in granting section 1782 applications. These factors
 3 include: (1) whether “the person from whom discovery is sought is a participant in the foreign
 4 proceeding;” (2) “the nature of the foreign tribunal, the character of the proceedings underway
 5 abroad, and the receptivity of the foreign government or the court or agency abroad to U.S. federal-
 6 court judicial assistance;” (3) whether the request is “an attempt to circumvent foreign proof-
 7 gathering restrictions or other policies of a foreign country or the United States;” and (4) whether the
 8 discovery is “unduly intrusive or burdensome.” *Intel*, 542 U.S. at 264-65; *see also Four Pillars*
 9 *Enters. Co. v. Avery Dennison Corp.*, 308 F.3d 1075, 1078 (9th Cir. 2002).

10 **B. Nokia’s Application Satisfies the Statutory Requirements**

11 Nokia’s request for discovery meets each of the three statutory requirements. First, the
 12 person from whom discovery is sought, Google, “resides or is found” in this District because its
 13 principal place of business is located in this district at 1600 Amphitheatre Parkway in Mountain
 14 View, California. 28 U.S.C. § 1782(a); (Ruga Decl., ¶ 4, Exh. 1) (excerpt of Google 2012 10K).

15 Second, the discovery of technical documents relating to Google-supplied features is sought
 16 for the purpose of establishing, at a minimum, Nokia’s infringement claims in Nokia’s action against
 17 HTC in Germany. *See* 28 U.S.C. §1782(a) (requiring that the discovery be sought for a “proceeding
 18 before a foreign tribunal.”); (Ruga Decl., ¶¶ 1-7). It is well settled that German courts qualify as a
 19 “tribunal” for purposes of Section 1782. *See, e.g., Kulzer v. Esschem, Inc.*, 390 F. App’x 88, 93 (3d
 20 Cir. 2010) (ordering discovery for use in German civil litigation); *see also Heraeus Kulzer v. Biomet,*
 21 *Inc.*, 633 F.3d 591, 594 (7th Cir. 2011).

22 Third, as a named party in the foreign actions, Nokia qualifies as an “interested party.” 28
 23 U.S.C. § 1782(a); *Intel*, 542 U.S. at 256 (“No doubt litigants are included among . . . the ‘interested
 24 person[s]’ who may invoke § 1782”); *see also Heraeus Kulzer*, 633 F.3d at 594. Accordingly, Nokia
 25 has satisfied the statutory requirements for an application under 28 U.S.C. § 1782.

26 **C. The Supreme Court’s *Intel* Factors Strongly Favor Nokia’s Application**

27 In addition to meeting the statutory requirements under Section 1782, the *Intel* factors

1 identified by the Supreme Court also weigh heavily in favor of the Court exercising its discretion to
 2 grant Nokia's request for discovery.

3 **1. Google Is Not a Party to the German Proceeding.**

4 The first *Intel* factor—whether “the person from whom discovery is sought is a participant in
 5 the foreign proceeding”—favors Nokia because Google is not a party to the German litigation. *See*
 6 *Intel*, 542 U.S. at 264 (explaining that “nonparticipants in the foreign proceeding may be outside the
 7 foreign tribunal’s jurisdictional reach; hence, their evidence, available in the United States, may be
 8 unobtainable absent § 1782 aid”).⁴

9 The material sought is technical information in Google’s possession and may not be within
 10 the foreign tribunals’ jurisdictional reach. The possibility that the requested discovery may not be
 11 available in the foreign proceeding further justifies Nokia’s request.

12 **2. Nokia Seeks Highly Relevant Information That Will Assist the Foreign
 13 Courts.**

14 The second factor articulated by the *Intel* Court “take[s] into account the nature of the foreign
 15 tribunal, the character of the proceedings underway abroad, and the receptivity of the foreign
 16 government or the court or agency abroad to U.S. federal-court judicial assistance.” *Intel*, 542 U.S.
 17 at 264. Because the nature and character of the foreign proceeding involves Nokia’s allegations of
 18 patent infringement, discovery of technical information regarding the accused features is critical.
 19 *See London v. Does*, 279 F. App’x 513, 515 (9th Cir. 2008) (affirming order granting 1782
 20 discovery when proof sought was “critical” in light of the “nature and character of the foreign
 21 case”); *In re Bayer AG*, 146 F.3d 188, 195-96 (3d Cir. 1998) (documents relevant to the foreign
 22 proceedings are “presumptively discoverable” under section 1782).

23 Nokia accuses HTC of infringing the patent at issue based on features implemented in HTC’s
 24 devices and provided by Google via its software on the HTC device working in concert with Google
 25 servers. (See Exhibit A (proposed subpoena); Ruga Decl., ¶¶ 2-3.) As a result of these claims,

26
 27 ⁴ Moreover, even if Google later intervenes in the litigation, German courts do not provide discovery
 28 comparable to that sought in this application. *See Heraeus Kulzer*, 633 F.3d at 597 (authorizing
 Section 1782 discovery because German litigant could not “obtain even remotely comparable
 discovery by utilizing German procedures”).

1 Nokia seeks discovery relevant to the function of Google's software and servers to enable Nokia to
 2 investigate fully and properly assert its infringement claims. More specifically, Nokia has focused
 3 its request on features of the Google servers and Android applications involved in providing the
 4 accused navigation functionalities. (See Exhibit A.)

5 Moreover, prior cases have recognized the receptiveness of German courts to the use of
 6 discovery obtained through Section 1782. *See e.g.*, *Kulzer*, 390 F. App'x at 93; *Heraeus Kulzer*, 633
 7 F.3d at 597.

8 **3. No Foreign Discovery Restrictions Bar Nokia's Requested Discovery**

9 The next Intel factor also weighs in Nokia's favor because this application is not an attempt
 10 to circumvent foreign proof-gathering restrictions. *Intel*, 542 U.S. at 260-63. “[O]nly upon
 11 authoritative proof that a foreign tribunal would reject evidence obtained with the aid of Section
 12 1782 should a district court refrain from granting the assistance offered by the act.” *In re Esses*, 101
 13 F.3d 873, 876 (2d Cir. 1996); *see also Euromepa S.A. v. R. Esmerian, Inc.*, 51 F.3d 1095, 1097, 1101
 14 (2d Cir. 1995) (permitting discovery under Section 1782 and observing that a court “can simply
 15 refuse to consider any evidence that [1782 applicant] gathers by what might be—under French
 16 procedures—an unacceptable practice”); *In re Application of Procter & Gamble Co.*, 334 F. Supp.
 17 2d 1112, 1116 (E.D. Wis. 2004) (holding that “to decline a § 1782(a) request based on foreign
 18 nondiscoverability, a district court must conclude that the request would undermine a specific policy
 19 of a foreign country or the United States”).

20 Here, Nokia is unaware of any restrictions on proof-gathering procedures that would prohibit
 21 obtaining the discovery it seeks through Section 1782. To the contrary, U.S. courts have routinely
 22 granted applications under Section 1782 for discovery of evidence to be used in German
 23 proceedings. *See, e.g.*, *Kulzer*, 390 F. App'x at 93 (ordering discovery for use in German civil
 24 litigation); *Heraeus Kulzer*, 633 F.3d at 594–97 (finding district court erred in denying application
 25 seeking discovery for use in German civil litigation).

26 **4. Nokia's Discovery Is Narrowly Tailored to Avoid Undue Burden**

27 The *Intel* Court finally noted that “unduly intrusive or burdensome requests may be rejected

1 or trimmed.” *Intel*, 542 U.S. at 265. This factor again weighs in Nokia’s favor because the proposed
 2 discovery requests are narrowly tailored and are not unduly burdensome. Nokia is requesting
 3 document discovery targeted to technical documents regarding specific the Google software that
 4 provides accused features used in HTC’s products (*see generally* Exhibit A; Ruga Decl. ¶¶ 2-3).
 5 The universe of responsive documents is thus likely to be reasonably focused and searchable,
 6 avoiding any undue burden on Google.

7 **D. Granting Nokia’s Application Will Promote Efficient Discovery**

8 Courts have also considered other evidence bearing on whether the discovery sought
 9 accomplishes the goals of the statute, which include “providing efficient means of assistance to
 10 participants in international litigation in our federal courts.” *Marubeni Am. Corp. v. LBA Y.K.*, 335
 11 Fed. App’x. 95, 96 (2d Cir. 2009) (internal quotation omitted). Here, Section 1782 provides an
 12 effective means for obtaining the discovery sought by Nokia. *See Kulzer*, 390 F. App’x at 93
 13 (ordering discovery for use in German civil litigation); *Heraeus Kulzer*, 633 F.3d at 594.

14 Indeed, courts in this Circuit have routinely permitted discovery under Section 1782, when,
 15 as here, the applicant has satisfied the statutory requirements and the above factors weighed in favor
 16 of granting relief. *See e.g.*, *In re Ex Parte Application of Nokia Corp. and Nokia GmbH.*, 12-cv-
 17 2653 BEN (WMC), slip op. (S.D. Cal. Nov. 19, 2012) (Ruga Decl., ¶ 16, Exh. 2); *In re Ex Parte*
 18 *Apple Inc.*, 12-cv-147 LAB (POR), slip op. (N.D. Cal. Jan. 25, 2012) (Ruga Decl., ¶ 17, Exh. 3); *In*
 19 *re Am. Petroleum Institute*, 11-80008- JF (PSG), slip op. (N.D. Cal. Apr. 7, 2011) (Ruga Decl., ¶ 18,
 20 Exh. 4); *In re Ecuador*, 2010 WL 3702427, at *2; *London*, 279 F. App’x at 513; *Chevron Corp. v. E-*
 21 *Tech Int’l*, 2010 WL 3584520 (S.D. Cal. Sept. 10, 2010); *Mirana v. Battery Tai-Shing Corp.*, No.
 22 08-80142, slip op. (N.D. Cal. Sept. 19, 2008) (Ruga Decl., ¶ 19, Exh. 5).

23 **VII. CONCLUSION**

24 Nokia seeks narrowly tailored discovery for use in a foreign proceeding. Because Nokia’s
 25 request satisfies the three statutory requirements of 28 U.S.C. § 1782, and because the *Intel* factors
 26 all weigh in favor of granting the application, Nokia respectfully requests that this Court issue an
 27 order authorizing the issuance of a subpoena in substantially the same form attached as Exhibit A to
 28

1 this application.

2
3 DATED: October 14, 2013

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